

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-23 are now pending in this application. Claims 1-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Skalla (USPN: 6,367,606). On page 5, paragraph 3 of the office action, the Examiner states that "Applicants' arguments filed 06/04/04 have been fully considered but they are not persuasive".

In paragraph 4, pages 5-6, of the office action, the Examiner has commented with respect to only the declaration of Scott Steckling filed with the Applicants' amendment on 12/16/03. The Examiner, on page 5 of the office action states "The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the prior art reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another." Further, on page 6 of the office action, the Examiner states,

"... statements [from Steckling Declaration] and the sign-in of Skalla are, in and of themselves, not considered to provide sufficient evidence supporting overcoming the prior art cited."

Applicants note that the Examiner does not comment on the Daniel R. Eagan declaration which was also filed under 37 C.F.R. §1.131 on December 16, 2003 along with the Steckling declaration. Daniel Eagan is not one of the inventors in the present application. The Eagan declaration was submitted as corroborating evidence to the Steckling declaration.

Applicants respectfully submit that the two declarations previously filed support that more than a mere conception of the invention was in hand prior to the effective date of the prior art reference. The Examiner's attention is directed to the Eagan declaration, paragraphs 5 and 6 and log attached as Exhibit A to the Eagan declaration that clearly establishes that a concrete chute with employed plastic liner was in existence as of August 23, 1999. The declaration further states that the liner on the test chute was held firmly in place by tabs and did not employ additional fasteners threaded or otherwise.

The Examiner is also directed to the Steckling declaration paragraph 5 that indicates that Steckling conceived of the plastic liner mounted in a metal frame without the use of fasteners prior to August 23, 1999.

On page 6 of the office action, the Examiner also states:

“As there is no evidence that Skalla did not invent the claimed apparatus before Applicants of the instant application, and the evidence presented in the Affidavit, taken either individually or as a whole, do not comprise sufficient evidence of conception, due diligence or reduction to practice, the date of the prior art reference US 6,367,606 B1 is considered still valid, and the rejection under 35 USC Sec. 103(a) is maintained.”

Applicants submit that the Examiner's position is not a correct statement of the burden the Applicants must meet in this matter. Applicants do not have to prove, as stated by the Examiner, that Steckling “did not invent the claimed apparatus before the Applicants”. The Applicants submit that their burden is to demonstrate by the preponderance of the evidence either reduction to practice before Skalla's priority date or prior conception coupled with reasonable diligence in reducing the invention to practice from a time just prior to Skalla's entry into the field to the Applicants' own reduction to practice. Applicants further submit that the two declarations and the exhibits to those declarations clearly meet the burden described above.

It is noted that the Skalla patent claims priority back to October 15, 1999 based on a filing date of a provisional application by Skalla. The Steckling and Eagan declarations clearly show that the conception and reduction to practice by the Applicants occurred at least as early as August 23, 1999 which is approximately two months prior to the earliest filing date claimed by Skalla.

Applicants also submit that the declarations establish that the Applicants were diligent from the time of conception to reduction of practice of the subject matter of the present application for the discharge chute for concrete disclosed and claimed in the present application.

From the record, it is clear that the earliest documented priority date/reduction to practice by Skalla is the filing of his provisional application allegedly filed on October 15, 1999 and the earliest documented indication of Mr. Skalla's knowledge of a concrete chute with a plastic liner is September 3, 1999 after his visit to Oshkosh Truck Corporation. The declarations of Mr. Steckling and Mr. Eagan clearly establish that the conception and reduction to practice of the concrete chute with a plastic liner as disclosed and claimed in the present application occurred at least as early as August 23, 1999 which precedes either of the Skalla dates. (See MPEP 2136.03 III)

Accordingly, the Skalla reference cannot be used to support this rejection. Based on the facts of the record, the timing of the filing and the issuance of Skalla does not qualify it as prior art for purposes of 35 U.S.C. §102 or §103. Therefore, Applicants respectfully request that the Examiner withdraw his rejection of claims 1-23. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

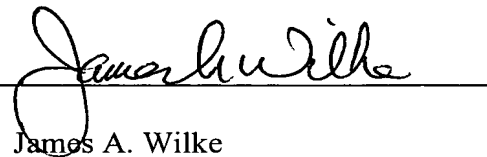
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 01-24-05

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By



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